

Application No. 10/663,316
Amendment dated December 18, 2006
Response to Office Action of October 17, 2006

Atty. Docket No. 42P17654
Examiner Ke Xiao
TC/A.U. 2629

Remarks

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. Claims 1, 12, 22, 32, 42 and 51 have been amended. No claims have been added or canceled. Thus, claims 1-60 are pending.

Claim Rejections - 35 U.S.C. § 102(e)

Claims 1-4, 7, 8, 11-14, 16-18, 21-25, 27-29, 51-54 and 56-58 were rejected as being anticipated by U.S. Patent Application Publication No. 2003/0210221 to Aleksic (*Aleksic*). Applicants respectfully submit that Applicants' invention as claimed is not anticipated by *Aleksic* for at least the following reasons.

Independent claim 1 recites:

determining an ambient light level for an operating environment of a display device having an adjustable backlight to provide variable brightness; and *modifying color luminance values* corresponding to one or more portions of an image to be displayed on the display device based on the ambient light level.

Claim 12 recites similar limitations. Independent claim 22 recites:

... a display device having an adjustable backlight source; and a graphics control device coupled with the ambient light sensor on the display device, the graphics control device to modify luminance values corresponding to one or more portions of an image and backlight intensity based on the sensed ambient light level.

Claim 51 recites similar limitations.

The Office Action points to *Aleksic*, page 3, paragraph [0029] as disclosing, "modifying a color brightness of one or more portions of an image to be displayed on the display device" and *Aleksic*, Fig. 4, elements 440 and 445 as disclosing, "[a] graphics

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control device to modify image brightness and backlight intensity based on the sensed ambient light level.”

Aleksic appears to disclose a “color correction of the LCD screen” “[i]f a dominant color of ... ambient light [is] detected” in order to maintain the “color constancy” “despite changes in the color of the ambient light.” Page 3, paragraph [0029]. Thus as Applicants have understood the reference, *Aleksic* discloses modification of color *hue*, the shifting of relative red, green and blue values, in response to the *color* of detected ambient light rather than “modifying ... color *luminance values*,” in response to the *level* of ambient light. Therefore, the reference fails to disclose or suggest at least one element of the claimed invention, and so fails to anticipate the invention as recited in claims 1, 12, 22, and 51.

Claims 2-4, 7, 8 and 11 depend from independent claim 1. Claims 13, 14, 16-18 and 21 depend from independent claim 12. Claims 23-25 and 27-29 depend from independent claim 22. Claims 52-54 and 56-58 depend from independent claim 51. Because dependent claims include the limitations of the claims from which they depend, applicants submit that claims 2-4, 7, 8, 11, 13, 14, 16-18, 21, 23-25, 27-29, 52-54, and 56-58 are not anticipated by *Aleksic* for at least the reasons set forth above.

Claim Rejections - 35 U.S.C. § 103(a)

The Office Action rejects claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Aleksic* in view of U.S. Patent Application Publication No. 2002/0154138 to Wada (*Wada*). For at least the following reasons set forth below, Applicants submit that claim 6 is not rendered obvious by *Aleksic* in view of *Wada*.

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“To establish a *prima facie* case of obviousness... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” See MPEP § 2143. Something in the prior art must suggest the desirability, and thus the obviousness, of making the combination proposed in an Office Action. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434, 1438 (CAFC 1988). Although an Office Action may suggest that an element of a primary prior art reference *could* be modified in view of a secondary prior art reference to form the claimed structure, the mere fact that the prior art *could* be so modified would not make the modification obvious unless the prior art suggested the desirability of the modification (emphasis added). In re Laskowski, 871 F.2d 115, 10 USPQ2d 1297 (CAFC 1989). There must be some supporting teaching in the prior art for the proposed combination of references to be proper. In re Newell, 891 F.2d 899, 13 USPQ2d 1248 (CAFC 1989).

Applicants respectfully submit that no such teaching or suggestion has been provided for combining the cited references, thus the combination of *Aleksic* and *Wada* is improper. *Aleksic* claims to disclose “a method of *conserving power* for LCD displays in low light conditions,” page 1, paragraph [0012], “relat[ing] generally to LCD displays and more particularly to LCD display *backlighting*,” page 1, paragraph [0001]. Conversely, *Wada* appears to disclose “an image display system of environment-compliant type, an image processing method and an information storage medium,” page 1, paragraph [0001], meant to provide consistent image quality independent of lighting. As Applicants have understood the references, *Aleksic* describes a method of conserving

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power by minimizing backlight usage whereas *Wada* merely pertains to a system for maintaining display properties irrespective of the color of room lighting, lacking any mention of power conservation or backlighting. Neither reference provides motivation or suggestion for combination of the arts of power conservation and environment-compliant images which are nonanalogous due to differing structure and function. See MPEP § 2141.01(a)(II),(IV).

The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. See MPEP § 2143.01(III). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. See Al-Site Corp. v. VSI Int'l Inc., 174 F.2d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). A statement that modifications of the prior art to meet the claimed invention would have been "*well within the ordinary skill of the art* at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also MPEP § 2143.01(IV). Applicants respectfully submit that no such objective reason for combination of the references has been set forth in the Office Action.

Because no objective suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, has

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been put forth the combination of *Aleksic* and *Wada* is invalid, thus dependent claim 6 is not rendered obvious.

The Office Action rejects independent claims 32 and 42 under 35 U.S.C. § 103(a) as being unpatentable over *Aleksic* in view of U.S. Patent No. 6,618,045 issued to Lin (*Lin*). For at least the following reasons set forth below, Applicants submit that claims 32 and 42 are not rendered obvious by *Aleksic* in view of *Lin*.

Independent claim 32 recites:

An article comprising a computer-readable medium having stored thereon instructions that, when executed, cause one or more computing devices to:
determine an ambient light level for a display device *having an adjustable backlight* to provide variable backlight intensity; and
modify a color brightness of one or more portions of an image to be displayed on the display device based on the ambient light level.

Independent claims 42 recites:

An article comprising a computer-readable medium having stored thereon instructions that, when executed, cause one or more computing devices to:
determine an ambient light level for a display device *having an adjustable backlight* to provide variable backlight intensity;
modify the backlight intensity based on the ambient light level; and
modify a color brightness of one or more portions of an image to be displayed on the display device based on the modified intensity of the adjustable backlight.

The Office Action points to *Aleksic*, Fig. 4, as disclosing one or more processing devices which “determine an ambient light level for a display device having an adjustable backlight to provide variable backlight intensity,” and “modify a color brightness of one or more portions of an image to be displayed on the display device based on the ambient light level [/ modified intensity of the adjustable backlight].” See pages 8, 9. Applicants respectfully disagree with this conclusion. As previously stated, *Aleksic* appears to disclose modification of color *hue* in response to the *color* of detected ambient light, page

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3, paragraph [0029], rather than “modifying ... color *brightness*” in response, either directly or indirectly, to the *level* of the ambient light as recited in the claims.

Furthermore, Applicants respectfully assert that the combination of *Aleksic* and *Lin* is improper. The proposed modification of the prior art cannot change the principle of operation. See MPEP §2143.01(VI). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). A proposed modification is invalid if the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which [it] ... was designed to operate.” *Id.*, 270 F.2d at 813, 123 USPQ at 352.

Aleksic claims to disclose “a method of *conserving power* for LCD displays in low light conditions,” page 1, paragraph [0012], “relat[ing] generally to LCD displays and more particularly to LCD display *backlighting*,” page 1, paragraph [0001]. *Lin* appears to disclose an “arrangement that dynamically adjust[s] certain operating settings associated with a computer monitor or display in response to detected environmental conditions.” Col. 1, lines 7-9. As Applicants have understood the reference, *Aleksic* describes a method of conserving power by minimizing backlight usage such that backlighting is adjusted according to changes in ambient lighting. Page 1, paragraph [0012]. Conversely, *Lin* appears to adjust one or more image display properties in response to changes in ambient lighting. Col. 5, lines 33-50. The proposed combination of *Aleksic* and *Lin* is invalid because it would “require a substantial reconstruction and

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redesign of the elements shown in [*Aleksic*] as well as a change in the basic principle under which [*Aleksic*] ... was designed to operate.” In re Ratti, 270 F.2d at 813, 123 USPQ at 352. Unlike Applicants’ system, which *balances* backlight intensity and color intensity changes, paragraph [0020], the combination of *Aleksic* and *Lin* provides for independent and potentially divergent solutions to the same event. For example, a simple combination of *Aleksic* and *Lin* could potentially adjust both backlight intensity and image brightness simultaneously in the same direction thereby overcompensating for changes in ambient light. Accordingly, the proposed combination could actually decrease image quality thereby undermining the principle of operation. Conversely, Applicants’ system coordinates adjustments to backlight intensity with those made to image brightness, thereby minimizing power consumption while maintaining overall image quality. See paragraph [0020]. Because *Aleksic* and *Lin* discloses no such functionality, Applicants respectfully assert that their combination would require substantial reconstruction and redesign rendering it improper. Therefore independent claims 32 and 42 are not rendered obvious by *Aleksic* in view of *Lin*.

Applicants further submit that the rejection is the result of impermissible hindsight. It is well settled in patent law that there must be something in the prior art as a whole to provide the motivation for, or suggest the desirability of, making the modification suggested by the Examiner. See, e.g., Fromson v. Advanced Offset Plate, Inc., 225 USPQ 26, 31 (Fed. Cir. 1985). It is well settled that

[I]t is impermissible within the framework of § 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such a reference fairly suggests to one of ordinary skill in the art.

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In re Wasselau, 147 USPQ 391, 393 (CCPA 1965).

Applicants respectfully contend that the Examiner's combination of cited references could only have been accomplished through carefully considered hindsight using Applicants' claims as a reconstructive guide. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art in order to render the claimed invention obvious. In re Fritch, 972 F.2d 1260, 23 USPQ2d 1789 (Fed. Cir. 1992). If the combination of *Aleksic* and *Lin* appears to be obvious as asserted by the Examiner, it is only as a result of hindsight gained from Applicants' claims.

Claims 33-41 depend from independent claim 22. Claims 43-50 depend from independent claim 42. Because dependent claims include the limitations of the claims from which they depend, applicants submit that *Aleksic* does not render claims 33-41 and 43-50 obvious in further view of *Lin* for at least the reasons set forth above.

The Office Action rejects claims 5, 9, 10, 15, 19, 20, 30, 31, 59 and 60 under 35 U.S.C. § 103(a) as being unpatentable over *Aleksic* in view of *Lin*. Claims 5, 9, and 10 depend from claim 1, claims 15, 19, and 20 depend from claim 12, claims 30 and 31 depend from claim 22, and claims 59 and 60 depend from claim 51. As discussed above, *Aleksic* does not teach or suggest the invention as claimed in claims 1, 12, 22, and 51 because *Aleksic* fails to disclose "modifying ... color [image] brightness."

As previously stated, Applicants respectfully assert that the combination of *Aleksic* and *Lin* is impermissible as requiring substantial modification and alteration of the basic principle of operation. See MPEP § 2143.01(VI). Because dependent claims include the limitations of the claims from which they depend, applicants submit that

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Aleksic does not render claims 5, 9, 10, 15, 19, 20, 30, 31, 59, and 60 obvious in further view of *Lin* for at least the reasons set forth above.

The Office Action rejects claims 26 and 55 under 35 U.S.C. § 103(a) as being unpatentable over *Aleksic* in view of U.S. Patent Application No. 2004/0156183 to Kim (*Kim*). Claim 26 is a dependant claim based on independent claim 22 and claim 55 is a dependent claim based on independent claim 51, therefore the prior art references when combined "must teach or suggest all the claim limitations," found in both the dependant and independent claims. See MPEP § 2143. As discussed above, *Aleksic* does not teach or suggest the invention as claimed in claims 22 and 51 because it fails to disclose "modifying ... color [image] brightness."

Applicants respectfully assert that the combination of *Aleksic* and *Kim* is invalid for lack of motivation. However, even if the combination of *Aleksic* and *Kim* is valid, whether or not *Kim* disclosed the specific elements of claims 26 and 55, it fails to cure the deficiencies of claims 22 and 51 from which they depend. As per MPEP § 2143.03, claims 26 and 55 are nonobvious over the cited references for at least the same reasons as claims 22 and 51. Therefore, *Aleksic* does not render the claims obvious in further view of *Kim*.

Conclusion

For at least the foregoing reasons, Applicants submit that the rejections of the claims have been overcome herein, placing all pending claims in condition for allowance. Such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present

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Respectfully submitted,

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